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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CONLEY, FREDRICK C

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/661,698	Applicant(s) FAIRCLOTH ET AL.	
	Examiner FREDRICK C. CONLEY	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 and 36 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,14,15,18,21,23-31 and 34 is/are rejected.
- 7) ☒ Claim(s) 12-13 16-17 19-20 22 32-33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
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| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-11, 14-15, 18, 23-25, 28-31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,175,230 to Herdal. in view of U.S. Pat. No. 4,091,481 to Redman.

Claims 1, 14, 23-25, 30, and 34, Herdal discloses a pillow assembly, comprising:

a cushioning member 10, said cushioning member including a cushioning medium 11, a front surface 13 and a back surface, said front surface and said back surface being connected along an outer perimeter of said cushioning member, said cushioning medium being between said front surface and said back surface;

a first cavity 12, said first cavity recessed from said front surface into said cushioning member, said first cavity having a first cavity opening of a predetermined dimension, a first cavity sidewall perimeter surface defined by an inner lining 13 extending across the top and and bottom cavity liners (14,15)(col. 1 lines 54-57) inherently longer than a depth of said cushion article at said outer perimeter where said first cavity sidewall perimeter surface is measured along said billowing from said first cavity floor surface to said front surface, and a first cavity floor surface 15 of a similar predetermined dimension, said first cavity sidewall perimeter surface connected to said first cavity floor surface,

and said first cavity sidewall perimeter surface encircled by said cushioning medium (fig. 1); at least one item removeably situated in said first cavity (col. 1 lines 20-22);

and, wherein said first cavity sidewall perimeter surface billows inward toward said first cavity (fig. 2) and capable of frictionally yet releasably holding at least one item; wherein said first cavity opening generally maintains said predetermined dimension in said open position and in said closed position, and said first cavity floor surface generally maintains said similar predetermined dimension in said open position and in said closed position;

wherein said first cavity sidewall perimeter surface billows in between said first cavity opening and said first cavity floor surface, said first cavity sidewall perimeter surface at least partially obscuring said first cavity floor surface when said at least one item is removeably situated in said first cavity and when said first cavity is empty, and a first door col. (1-2 lines 69-72 & 1-4). Herdal fails to disclose indicia on the cushioning member, first door, or first item and said cushioning member having an outline that is shaped to further visually indicate said illustrated theme. It is well known and considered an obvious modification to employ indicia on a surface, such as a team logo or alter the shape, however, Redman discloses a pillow having a door with indicia, an item 26, and an outer perimeter that represents a illustrative them (fig. 1). It would have been obvious for one having ordinary skill in the art at the time of the invention to employ indicia on the pillow, first door, or first item and alter the outer perimeter as taught by Redman in order to personalize and provide a novelty pillow (col. 1 lines 5-8).

Herdal fails to disclose the first door open to a position that reveals all of the first cavity opening. It is considered an obvious modification to merely have the first door open to a position that reveals all of the first opening and it would have been obvious for one having ordinary skill in the art at the time of the invention to have the first door open to a position that reveals the cavity opening in order to have minimum effort to have access to the cavity. With regards to the Applicant's recitation "for playing peek-a-boo hide and seek" the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claims 5 and 28, wherein said first cavity opening has a perimeter and where said first door (26,27) has a larger perimeter than said first cavity opening perimeter so as to overlay a portion of said front surface (fig. 2). With regards to the cavity and first door having a circumference, Herdal discloses that the pillow is capable of being configure to have a round shape (col. 2 lines 21-25).

Claim 6, wherein said outer perimeter of said cushioning member has a generally rectangular outline (fig. 1), said outline encircling a cushioning member 11 frontal area, said first cavity opening encircling an opening area (fig. 2). Herdal fails to disclose the opening area is at least 18% of the size of said cushioning member frontal area. A change in size is considered an obvious modification and it would have been obvious for one having ordinary skill in the art at the time of the invention to have the dimensions as stated above in order to hold the item within the cavity of Herdal.

Claim 7, wherein said cushioning member includes a shell, said shell housing said cushioning medium, and said shell and cushioning member comprising a quilted fabric material (col. 1 lines 47-67).

Claims 8 and 29, Herdal discloses an embodiment wherein said first cavity floor surface 15 is attached via stitching 17 proximate to said back surface and capable of preventing said first cavity sidewall perimeter surface and said first cavity floor surface from turning inside out.

Claim 9, Herdal, as modified, discloses the first door connected to the front surface, said first door opening by bending and said first door inherently conforms to said front surface in said closed position, said front surface 13 being convexly contoured toward the cavity via the cushioning member 11 and a securing means (35,36).

Claims 10 and 18, Herdal, as modified, discloses all of the Applicant's claimed limitations except for a second door connected to the cushioning member. Redman discloses a pillow having a door 20 defining a cavity. It would have been obvious for one having ordinary skill in the art to employ a door as taught by Redman in order to hold baby teeth and coins.

Claim 11, wherein said first door and said second door inherently conceal said first cavity when said first door and second door are in the closed position.

Claims 15 and 31, wherein said cushioning member 11 includes an outer perimeter surface, said outer perimeter surface connected to an outer perimeter of said front surface 13 and connected to said back surface, said outer perimeter surface providing depth to said cushioning member (fig. 2).

Claims 2 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,175,230 to Herdal. in view of U.S. Pat. No. 4,091,481 to Redman as applied to claims 1, 5-8, 10, 15, 23-25, 28-29, 31, and 34 as stated above and further in view of U.S. Pat. No. 5,788,468 to Saarela et al.

Claims 2 and 26, Herdal, as modified, discloses all of the Applicant's claimed limitations except for a stuffed animal. Saarela discloses a pillow having a pocket 15 receiving a stuffed animal 18. It would have been obvious for one having ordinary skill in the art at the time of the invention to employ a stuffed animal as taught by Saarela in order to provide a source of physical comfort and visual attractiveness (col. 1 lines 4-9).

Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,175,230 to Herdal. in view of U.S. Pat. No. 4,091,481 to Redman as applied to claims 1, 5-8, 10, 15, 23-25, 28-29, 31, and 34 as stated above and further in view of U.S. Pat. No.3,378,948 to Gervaise.

Claims 4 and 27, Herdal, as modified, discloses all of the Applicant's claimed limitations except for a sound device that emits a sound that indicates an illustrative theme. Gervaise discloses a pillow having a decorative theme 48 illustrating bells and a sound device/bell 38 that produces a sound that further indicates the illustrative theme. It would have been obvious for one having ordinary skill in the art at the time of the invention to employ a bell and illustrative them as taught by Gervaise in order to provide plaything for children.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,175,230 to Herdal. in view of U.S. Pat. No. 4,091,481 to Redman as applied to claims 1, 5-8, 10, 15, 23-25, 28-29, 31, and 34 as stated above and further in view of further in view of U.S. Pat. No. 6,105,188 to Perez-Mesa et al.

Claim 21, Herdal discloses all of the Applicant's claimed limitations except for a blanket and a container sized to hold the pillow and blanket. Perez-Mesa discloses a blanket 14 and a container 26 capable of holding a pillow 40 and blanket. It would have been obvious for one having ordinary skill in the art at the time of the invention to employ a container and blanket as taught by Perez-Mesa in order to provide portable bedding.

Allowable Subject Matter

Claims 35 and 36 are allowed.

Claims 12-13, 16-17, 19-20, 22, and 32-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 3/11/08 have been fully considered but they are not persuasive.

With regards to the Applicant's recitation "capable of frictionally yet releasably holding", a recitation of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. As previously stated the first cavity sidewall perimeter surface of Herdal billows inward toward said first cavity as clearly illustrated in figure 2. Therefore the prior art structure pillow assembly of Herdal is capable of frictionally yet releasably holding an item since it meets the Applicant's structural limitation thus meeting the claim. Claims are given the broadest reasonable interpretation and limitations in the specification are not read into the claims. However as previously argued, If the night wear is either rolled or folded it would prevent the items from being mussed or crumpled and would clearly provide sufficient stability to frictionally yet releasably hold said items. Furthermore, a user is again inherently capable of storing other items than night wear within the cavity of Herdal such that all items would occupy enough space to frictionally yet releasably be held in place. The Applicant continues to merely rely on the sidewall perimeter surface that billows inward toward the first cavity to provide a means to frictionally yet releasably hold an item and, this feature is clearly taught by Herdal wherein the perimeter surface of the sidewalls are capable of frictionally yet releasably holding an item depending on the item chosen by the user being stored in the cavity of the pillow.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Herdal discloses a pillow assembly having a door to conceal items. Redman discloses a pillow having a door with indicia, an item 26, and an outer perimeter that represents an illustrative them (fig. 1). The combination as a whole would suggest to one having ordinary skill in the art at the time of employing indicia on the pillow, first door, or first item and alter the outer perimeter as explicitly recited by Redman in order to personalize and provide a novelty pillow (col. 1 lines 5-8). As previously stated, it is well known and considered an obvious modification to employ indicia on a surface, such as a team logo or alter the shape and is not considered a novel concept to do so. In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Therefore, Redman clearly suggest the general concept of providing indicia on a facing

surface such as a door that conceals an item and alter the shape in accordance with said item for the purpose of providing a novelty pillow.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FREDRICK C. CONLEY whose telephone number is 571-272-7040. The examiner can normally be reached on M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PATRICIA L. ENGLE can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/FREDRICK C CONLEY/
Primary Examiner, Art Unit 3673